

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Continuation Patent Application of Chris Quinlan and Edward A. Devlin

Confirmation No.: 8510

Serial No.: 10/661,886

Art Unit: 3688

Filed: September 15, 2003

Examiner: Daniel Lastra

Title: METHOD AND SYSTEM FOR REDEEMING PRODUCT
MARKETING REBATES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant respectfully requests review of the final rejection in the above-identified application in view of the following remarks.

Claims 102 -126 are pending. All claims stand rejected under 35 USC 102(e) as anticipated by U.S. Pat. Pub. No. 2001/0018664 ("Jacoves"). The rejections are improper.

I. Background

The pending claims are generally directed to a method and system of redeeming rebates where a unique transaction identifier is assigned at a point of sale which identifies the purchase transaction (but not the specific products) in which a customer purchases products, some of which may be eligible for a rebate. The customer can submit a rebate claim at a later point in time by submitting the transaction identifier and without the need to submit product specific information, *i.e.*, UPC codes, which is currently required in the prior art. Thus, the customer is

able to evidence his purchase of a rebated product solely from the submission of the assigned transaction identifier, and once the rebate is validated, the rebate value is transferred to the customer.

Jacoves is directed to a system and method of providing discounts in a multiple product discount environment, *i.e.*, a purchase of one product from one retailer provides a discount of the purchase of another product from a different retailer, and for collecting sufficient information relating to the purchase transactions so that a clearinghouse can facilitate payment between the retailers related to the discounted items. Jacoves discloses that a customer can purchase a product and receive a receipt which includes a redemption slip at the point of sale which identifies an award amount which can be used in the subsequent purchase of another product, *i.e.*, fuel in the example described. (Fig. 5, para. 38-41) In order to redeem the award, the customer inputs its identity and the value of the award to be redeemed. (Paragraph 0045). "The identifier of the purchaser may also be provided by a code which is entered manually by the user, such as a four digit code identifying a particular unit of accumulated credit discounts which should be applied to the gasoline purchase." (Paragraph 0045). Based on the value of the award submitted by the customer, the customer receives an instant discount on the purchase of the fuel.

II. The examiner's interpretation of the cited art is contrary to the examiner's previous Office Action in the present application and is inconsistent with the final Office Action issued in related Application No. 10/768,639 (the '639 Application) currently under appeal.

In the previous Office Action dated January 9, 2009, the examiner rejected all claims as anticipated by Jacoves. The examiner asserted that Jacoves discloses the use of the claimed "transaction identifier" to redeem an instant discount. Specifically, the examiner cited paragraph 0049 as disclosing assigning a unique transaction identifier at a point of sale. In response, the applicant noted that paragraph 0049 discloses a "four-digit code for providing the fuel reward

program system with input information to identify the total accumulated discount to be applied to the later gasoline purchase at the second point of sale.” Applicant also noted that this is the same four digit code which is discussed in paragraph 0045 which keeps track of “accumulated credit discounts.” Applicant further noted that there is no disclosure that this four-digit code is unique to the transaction, and having only four digits means that it is impractical for use to uniquely identify a transaction.

In the present final Office Action, the examiner, for the first time asserts that the unique identification for a purchase transaction (UID) in paragraph 0042 is the recited “transaction identifier.” However, the UID is not disclosed as being used by the customer in order to redeem a rebate, and the examiner has acknowledged, during the prosecution of this application as well as the prosecution of the related ‘639 Application, that he understands that it is the four digit code which is used to redeem the instant discount in Jacoves. Specifically, in the ‘639 Application, the examiner has stated:

Thus, according to the applicant, Jacoves does not disclose a method where a unique transaction identifier is assigned at the point of sale for subsequent use later by the purchaser to redeem a rebate. The examiner answers that Jacoves’ “4 digit code” is a unique transaction identifier because said code is printed on a redemption slip 212 at a first POS terminal (see paragraph 49) and where said code is used to identify a purchaser in a second POS terminal in order to identify the accumulated discount credit which should be applied according to the data stored in a third database 618 of the data processing system 600 of figure 4 (see paragraph 45). Therefore, contrary to the Applicant’s argument, said “4 digit code” is unique as said “4 digit code” function (sic) as a purchaser’s identifier in order to identify the accumulated discount credit which should be applied to purchaser. (Office Action dated July 8, 2009, p. 9)

Thus, the examiner has made it clear that he considers the “four digit code” to be the claimed “transaction identifier” and it is the “four digit code” that is used to match the purchaser rebate claim with the purchase data record as claimed.

However, in the present application, the examiner has, without explanation, abandoned the position he took in the '639 Application and now asserts that the UID described in paragraph 0049 is the recited "transaction identifier" which is used to redeem the instant discount. It is manifestly unfair for the examiner to completely switch positions, without explanation, and without affording the Applicant an opportunity to address the new rejection before making the rejection final. It is also manifestly unfair for the examiner to take one position in one application under appeal, and take a contrary position on another application under appeal.

III. The rejection of the claims as anticipated by *Jacoves* is improper as *Jacoves* does not disclose the recited "transaction identifier"

While *Jacoves* specifically identifies the UID as the unique transaction identifier in paragraph 0042, there is no disclosure that this UID is used to ascertain the applicability of promotions to the products purchased in the purchase transaction as recited in independent claims 102, 104, 110, 116, 121 and 124. Claim 102 is representative, and recites:

using at the processing site, the unique transaction identifier provided by the purchaser to access the information provided by the supplier and the marketing entity to ascertain the applicability of promotions to the goods in the identified purchase transaction.

Throughout the *Jacoves* specification, the redemption of the instant discount is described and in no instance is the UID used to ascertain the applicability of promotions to the goods in the identified purchase transaction and the value associated therewith. The examiner asserts this limitation is found at paragraph at [0071]. However, paragraph [0071] recites:

However, if a redemption slip 212 has been provided, the program will flow from decision block 1910 along the "Y" path to a function block 1914. Function block 1914 indicates the operation wherein the discount is applied. The program then flows to a function block 1916 wherein the redemption field, labeled "redeemed" in the redemption file, is updated. The redemption file contains only the UID, and the time and date stamp. The program will then flow to function block 1912 and then to the End block 1914.

Note that the UID is not used at all until after the discount is applied and that it is only used with respect to updating the redemption file. However, the redemption file does not contain “information provided by the supplier and the marketing entity” as claimed because “the redemption file contains only the UID and the date and time stamp.” All other uses of the UID described in *Jacoves* is by the clearinghouse after the redemption has already taken place and are therefore not relevant to the claimed limitations. Thus, the citations to the prior art do not support the examiner’s rejection of Claim 102.

The other independent claims recite similar uses of the transaction identifier to validate a rebate claim submitted by a customer and should therefore be allowable for the same reasons as Claim 102 discussed above.

The remaining claims ultimately depend from their respective independent claims and are therefore allowable with their respective independent claims without regard to the further patentable limitations respectively recited therein.

Respectfully submitted,

/pdm/

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Dated: February 3, 2010